

### **REMARKS/ARGUMENTS**

Claims 1-11, 13-19 and 21-33 are pending. As noted above, claims 1, 13, 15, 17, 18, 27, 29 and 33 have been amended. Support for these amendments may be found throughout the Specification. *See, e.g.*, Specification, paragraphs [0062] and [0064]. No new matter is added.

Applicants respectfully request reconsideration of this application based on the following remarks.

#### ***Claim Rejections – 35 USC § 103***

##### **I. Claims 1-3, 7-11, 13, 15, 18, 21-27, and 29-33 Rejected Under 35 U.S.C. § 103(a)**

Claims 1-3, 7-11, 13, 15, 18, 21-27 and 29-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,130,284 to Lee, et al. (hereinafter, "Lee") in view of U.S. Patent Application Publication No. 2001/0016493 to Kim, et al. (hereinafter, "Kim"). This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, all of the claimed features must be taught or suggested by the references and there must be some explicit reason to combine reference teachings. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

Lee and Kim, alone or in combination, fail to disclose or suggest the features recited by the claims. For example, claim 1 recites, among other subject matter, "a first modem processor operative to . . . receive a first message from the first wireless network to perform [a] handoff to the second wireless network, wherein the first message comprises a list of target cells in the second wireless network determined by the first wireless network to have a target cell location corresponding to a location of the wireless device, transmit a search message comprising a list of frequencies corresponding to the target cells to search for in the second wireless network, and provide notification of the handoff" and "a second modem processor operative to receive the search message and determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result, acquire synchronization and timing for each cell for which pilot acquisition is determined, exchange a second message with the second wireless network implementing a second radio access technology from 3rd Generation Partnership Project 2 (3GPP2) to establish a new call with the second wireless network via one of the cells in the search result." Independent claims 13, 15, 18, 27, 29 and 33 each include similar subject matter.

The Office Action, on page 5, asserts Lee discloses "wherein the handoff is triggered by the first wireless network based on location information." Specifically at col. 2, lines 24-26, Lee discloses a system and method in which "the mobile station receives from an async base station a direction message to detect information about sync base stations adjacent to the async base station." As such, Lee teaches that the information provided by the async base station is about sync base stations *adjacent to the async base station*. Thus, Lee teaches providing information based on the location of the async base station.

Receiving a message, as disclosed in Lee, with the information about sync base stations adjacent to the async base station does not disclose or suggest receiving "a first message from the first wireless network to perform [a] handoff" wherein "the first message comprises a list of target cells in the second wireless network determined by the first wireless network to have a target cell location corresponding to a location of the wireless device" and "a second modem processor operative to receive the search message and determine pilot acquisition for the list of frequencies and additional frequencies not included in the list of frequencies to produce a search result," as recited in claim 1. In fact, the disclosure of Lee to provide information based on the async base station location teaches away from the recited subject matter, which provides information based on the location of the wireless device.

Thus, for at least this reason, Lee fails to disclose or suggest the recited subject matter. Kim is silent with respect to this subject matter, and thus fails to cure the deficiencies of Lee. Furthermore, Lee cannot be properly modified to form the recited subject matter, as doing so would change the principle of operation of Lee.

Additionally, Lee and Kim fail to disclose or suggest determining pilot acquisition for the list of frequencies and additional frequencies not included in the list to produce a search result, acquiring synchronization and timing for each cell for which pilot acquisition was determined, and exchanging a second message to establish a new call via one of the cells in the search result. As such, the new call may be established with a cell on one of the additional frequencies not included in the list.

The Office Action, on page 6, admits that Lee fails to disclose determining a "pilot acquisition for additional frequencies not included in the list of frequencies," and relies on Kim to cure this deficiency.

Kim, in the Abstract and paragraphs [0059]-[0062], discloses a method “for an idle state handoff in a cellular system” where “a pilot signal is detected from the neighboring base stations by the mobile telephone, and it is then determined whether the detected neighboring base station is included in the list of the neighboring base stations. *If the detected neighboring base station is not included in the list, it [is] recognized as a handoff failure.*” (emphasis added).

Since Kim teaches that the handoff is recognized as a failure if the detected pilot signal is not included in the list of the neighboring base stations, Kim does not disclose or suggest adding the detected pilot signal to the list of neighboring base stations or using the detected pilot signal in establishing the new call.

Thus, in combining Kim with Lee, upon detecting that the pilot signal is not included in the list of the neighboring base stations, the handoff would fail, and would not result in producing a search result with the “additional frequencies not included in the list of frequencies” and establishing “a new call with the second wireless network via one of the cells in the search result,” as recited in amended claim 1.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claims 1, 13, 15, 18, 27 and 29. Claims 2-3, 7-11, 21-26 and 30-32 depend either directly or indirectly from claims 1 and 18, respectively. Thus, Applicant submits that claims 2-3, 7-11, 21-26, and 30-32 are allowable at least for the reason that they depend from an allowable base claim, as well as the additional features recited therein.

Therefore, for at least these reasons, the Examiner is respectfully requested to withdraw the rejection of claims 1-3, 7-13, 15, 18, 21-27 and 29-32 under 35 U.S.C. § 103(a) as being unpatentable over Lee in view of Kim.

## **II. Claims 4, 14, 16, 19, and 28 Rejected Under 35 U.S.C. § 103(a)**

Claims 4, 14, 16, 19, and 28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Kim in view of U.S. Patent Application Publication No. 2003/0139184 to Singh, et al. (hereinafter “Singh”). Claims 5 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee and Kim in view of U.S. Patent Application Publication No. 2004/0203469 to Patel, et al. (hereinafter “Patel”). These rejections are respectfully traversed.

Claims 4-6, 14, 16, 19 and 28 depend either directly or indirectly from claims 1, 13, 15, 18, and 27, respectively, and thus are allowable for at least the same reasons as discussed above. Further, these claims separately recite a combination of subject matter this is not disclosed or suggested by any combination of the cited references.

Thus, the Examiner is respectfully requested to withdraw the rejection of claims 4-6, 14, 16, 19 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Lee and Kim in view of Singh.

**III. Claim 17 Rejected Under 35 U.S.C. § 103(a)**

Claim 17 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Singh in view of Lee, in further view of Kim. This rejection is respectfully traversed.

As previously discussed, Lee and Kim do not disclose or suggest "wherein the handoff is triggered by the UMTS based on location information for the wireless device," as recited in claim 17. Singh does not cure the deficiencies of Lee and Kim.

In light of the foregoing, Applicant respectfully requests withdrawal of the rejection of independent claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Singh in view of Lee, in further view of Kim.

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Amendment dated December 21, 2009  
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### CONCLUSION

In light of these remarks, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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